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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,086	09/26/2000	Yuji Sawada	55168(55)	4078
21874	7590	11/10/2004	EXAMINER	
EDWARDS & ANGELL, LLP P.O. BOX 55874 BOSTON, MA 02205			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/647,086

Applicant(s)

SAWADA ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-19, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5.11.12</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/8/2004 has been entered.

Summary

Claims 1-30 are pending in the instant application.

Claims 1-19 and 29-30 have been withdrawn.

Claims 20-28 constitute the claims under active prosecution in this application

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-28 are rejected under 35 U.S.C. 112 Second Paragraph.

Referring to claims 20-28. Claims 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites, "A CPU controlling each of said storage apparatus..." This can be construed to indicate a plurality of storage apparatuses. This is inconsistent with the first part of claim 20, wherein merely a single storage apparatus is claimed.

Claim 25 recites, "A CPU controlling each of said external storage medium identification reading apparatus..." This can be construed to indicate a plurality of external medium identification reading apparatuses. This is inconsistent with the first part of claim 20, wherein merely a single external storage medium identification reading apparatus is claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 20-28 are rejected under 35 U.S.C. 102(e) as being anticipated by
Wiser U.S. Patent Number 6,385,596.**

Referring to claim 20. Wiser discloses a data reproducing apparatus reproducing digital data including reproducing apparatus specifying information specifying an apparatus capable of reproduction, comprising:

- A storage apparatus (Wiser: "Music Distribution Center **124**") storing reproduction apparatus ID information unique to said reproducing apparatus (Wiser: column 8, lines 1-42 and Figure 3);
- A first determining apparatus determining whether said reproducing apparatus is capable of reproducing said digital data from said reproduction apparatus ID information and said reproducing apparatus specifying information (Wiser: column 8, lines 43-56, "Passport");
- A control apparatus enabling or disabling reproduction of digital data by said reproducing apparatus dependent on the result of determination by said first determining apparatus (Wiser: column 8, line 43 to column 9, line 37) and

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- A CPU controlling each of said storage apparatus said first determining apparatus and said control apparatus (Wiser: Figure 1).

The Examiner notes, the passport as disclosed by Wiser is a data object that provides the security information particular to each user of the system. Each user is issued a passport by the media licensing center during the registration process. The passport is stored on the user's computer and used during playback to decrypt the media key for each media data file purchased by the user. Whereas encrypting the media key of a purchased media data file with the public key of a user's media player binds the media data file to a specific user, the user's passport in turn enables (i.e. control apparatus) the user to decrypt the file and play it back on her media player.

Referring to claim 21. Wiser further discloses a data reproducing apparatus wherein:

- Said digital data includes display data reproduced visually (Wiser: abstract); and
- Said reproducing apparatus comprising a display apparatus for visually reproducing and displaying said digital data (Wiser: abstract).

Referring to claim 22. Wiser further discloses a data reproducing apparatus further comprising an ID information input apparatus responsive to determination by said first determining apparatus that said reproducing apparatus is not a reproducing apparatus capable of reproducing said digital data, urging a user to enter a reproducing

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apparatus ID information (Wiser: column 9, lines 25-37, "The user is required to enter his/her passphrase upon playback in order to decrypt the registration key **420**.")

Referring to claim 23. Wiser further discloses a data reproducing apparatus comprising:

- A second determining apparatus determining whether the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproducing apparatus capable of reproducing said digital data; wherein said control apparatus enables or disables reproduction of digital data by said reproducing apparatus dependent on the result of determination by said second determining apparatus (Wiser: column 18, lines 5-44).

Referring to claim 24. Wiser further discloses a data reproducing apparatus comprising:

- An update selecting apparatus responsive to the determination by said second determining apparatus that the data reproducing apparatus specified by the reproducing apparatus ID information input by said ID information input apparatus is a reproduction apparatus capable of reproducing said digital data, allowing the user to select whether said reproducing apparatus specifying information is to be updated by said input reproducing apparatus ID information (Wiser: column 17, lines 35-52); and
- An updating apparatus responsive to the selection by said update selecting apparatus that said reproducing apparatus specifying information is to be

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updated by said reproducing apparatus specifying information by said input reproducing apparatus ID information (Wiser: column 17, lines 35-52).

Referring to claims 25-26. Claims 25-26 are rejected under the same rationale as set forth above in claims 20-24.

Referring to claim 27. Wiser further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when reproduction is first performed by the data reproducing apparatus (Wiser: Figure 3).

Referring to claim 28. Wiser further discloses a data reproducing apparatus wherein said reproducing apparatus specifying information is recorded when the digital data is sold (Wiser: Figure 3).

Response to Arguments

Applicant's arguments are moot in view of the new grounds for rejection.

Examiner's Comments

The Examiner is resending the requested signed copies of the PTO-1449 forms that correspond to the following submissions:

IDS: Paper No. 5	2/8/2001
IDS: Paper No. 11	12/22/2003
IDS: Paper No. 12	3/11/2004

If the Applicant does not receive the aforementioned PTO-1449 forms, the Applicant should call the Examiner promptly at the phone number specified below in order to rectify the situation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ginter, U.S. Patent Number 5,892,900, April 6, 1999, discloses systems and methods for secure transaction management and electronic rights protection.

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Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MSG
Patent Examiner
November 3, 2004